

REMARKS

In response to the above-identified Office Action, Applicants seek reconsideration in view of the following remarks. In this response, Applicants do not add, cancel or amend any claims. Accordingly, claims 35-49 and 53-56 are pending.

I. Claims Rejected Under 35 U.S.C. § 102

Claims 35-38 and 40-53 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,333,973 issued to Smith, et al. (hereinafter "Smith"). Applicants respectfully disagree for the following reasons.

It is axiomatic that to anticipate a claim, the Examiner must establish that each element of the claim is taught by a single reference. In regard to independent claims 35, 44, 47 and 53, these claims include the elements of automatically selecting a form for a message to be transmitted based on content of the displayed information at the time the user initiates a transmission mode. See, for example, claim 35, lines 6-8. The Examiner has cited col. 8, lines 26-45 and 52-65 and col. 10, line 61 through col. 11, line 9 as teaching these elements of the claims. See page 3 and page 6 of the Examiner's Office Action, Paper No. 18. Applicants have reviewed the cited sections of Smith and have been unable to discern any part therein that teaches these elements of claims 35, 44, 47 and 53. Rather, the cited sections of Smith discuss a message center program that allows a user to view received messages (col. 8, lines 26-45), obtain detailed information about received messages (col. 8, lines 52-65), and initiate a composition of a return SMS message by selecting a tool box menu and then selecting a "write" or "type" option that allows a user to generate a return message (col. 10, lines 61 through col. 11, line 31). Applicants have been unable to discern any part of these discussions in the cited sections that mention a user initiating a transmission mode and in response to the initiation of the transmission mode automatically selecting a form of a message to be transmitted where that form is selected based on the content of displayed information at the time the transmission mode is initiated. A program to allow the viewing of information about received messages and creation of messages after a user selects an option does not appear to teach automatically selecting a form for a message when a transmission made is entered as claimed in

each of the independent claims 35, 44, 47 and 53. Applicants invite the Examiner to clarify how the cited sections teach these elements if the rejection is maintained. Thus, the Examiner has failed to establish that Smith teaches each of the elements of claims 35, 44, 47 and 53. Accordingly, reconsideration and withdrawal of the anticipation rejection of these claims are requested.

In regard to claims 36-37, 43, 45, 46, 48 and 49, these claims depend from independent claims 35, 44, and 47 and incorporate the limitations thereof. Thus, at least the for the reasons mentioned above in regard to independent claims, these dependent claims are not anticipated by Smith. Accordingly, reconsideration and withdrawal of the anticipation rejection of these claims are requested.

In regard to claim 38, this claim includes elements similar to those in claims 35, 44, 47 and 53. Specifically, claim 38 includes the elements of monitoring the content of data being received and in response to detecting predetermined content automatically entering a mode to allow a user to transmit a message. The Examiner cites the same sections of Smith alleged to teach the elements of claims 35, 44, 47 and 53, namely, col. 8, lines 26-45 and col. 10, lines 61 through col. 11, line 19 as teaching these elements of claim 38. As discussed above, Applicants have been unable to discern any part of the cited sections of Smith that teach the elements of claim 38. The Applicants have been unable to discern any part of the cited sections that teach monitoring received data for predetermined content and in response to detecting this content automatically entering a mode for a user to transmit a message. Thus, the Examiner has failed to establish that Smith teaches each of the elements of claim 38. Applicants invite the Examiner to explain how the cited sections of Smith discussed above teach these elements of claim 38 if the rejection is maintained. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 38 are requested.

In regard to dependent claims 39-42, these claims depend from independent claim 38 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 38, Smith does teach the elements of each of these claims. Accordingly, reconsideration and withdrawal of the anticipation rejection of these claims are requested.

II. Claims Rejected Under 35 U.S.C. § 103

Claims 39 and 54-56 stand rejected under 35 U.S.C. § 103 as being unpatentable over Smith in view of U.S. Patent No. 6,301,338 issued to Mäkelä, et al. (hereinafter "Mäkelä"). Applicants respectfully disagree for the following reasons.

In order to establish a *prima facie* case of obviousness, the Examiner must show that the cited references, combined, teach or suggest each of the elements of a claim. In regard to claims 39, 54 and 55, these claims depend from independent claims 38 and 53 and incorporate the limitations thereof. Thus, for the reasons mentioned above, Smith does teach each of the elements of these claims. Further, Mäkelä does not cure the defects of Smith. The Examiner has not indicated and Applicants have been unable to discern any part of Mäkelä that teaches or suggests automatically entering a mode for allowing a user to transmit a message upon detecting predetermined content in received data or automatically entering a transmission mode to allow a user to transmit an electronic mail message in response to detecting predetermined content in data being received.

Further, the Examiner admits that Smith fails to teach automatically selecting a message to be transmitted in response to detecting predetermined content. See page 6, paragraph 5 of Paper No. 18. The Examiner relies on col. 5, line 53 through col. 6, line 16 of Mäkelä to teach these elements of the claims. However, the Applicants have reviewed the cited section of Mäkelä and have been unable to discern any point therein that teaches monitoring received data for predetermined content and upon detection of the predetermined content automatically entering a mode for allowing a user to transmit a message. Rather, the cited section of Mäkelä teaches sending an auto-reply message based on the phone number of a received call or message. The phone number is not content of a received message, rather it is an identity code related to such a message and thus is not predetermined content to be detected as recited in the claims. See col. 5, lines 53 and 54 of Mäkelä. Therefore, the Examiner has not established that Smith in view of Mäkelä teaches or suggests each of the elements of claims 39, 54 and 55. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

In regard to claim 56, this claim also includes many of the elements of claims 39 and 54 and 55. Specifically, claim 56 includes the elements of a control circuit to detect predetermined content in received data and to enter a transmission mode to allow a user to transmit an electronic mail message in response to detecting predetermined content. Thus, for the reasons mentioned above, Smith in view of Mäkelä does not teach these elements of claim 56. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claim 56. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 56 are requested.


CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 35-49 and 53-56 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 3, 2004.


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